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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/005,318	01/09/1998	MICH B. HEIN	310098401C1	2353
826	7590	11/28/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ROMEON, DAVID S	
		ART UNIT	PAPER NUMBER	
		1647		

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/005,318	HEIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David S. Romeo	1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 September 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 42,52,54-60,62-65,67-69,73,76 and 81 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 42,52,54-60,62-65,67-69,73,76 and 81 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 0906.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

The amendment filed 09/11/2006 has been entered. Claims 42, 52, 54–60, 62–65, 67–69, 73, 76, and 81 are pending.

Applicants' election of the species of targeting molecule comprising a J chain encoded by 5 nucleotides 1-213 of SEQ ID NO: 8 covalently linked via a peptide bond to an antigen combining site is acknowledged. Election was made **without** traverse in the paper filed 12/18/2002.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 09/11/2006 is sufficient to overcome the 10 rejection of claims 73 and 76 under 35 U.S.C. 112, first paragraph, based upon the scope of enablement as set forth in the last Office action.

### **Maintained Formal Matters, Objections, and/or Rejections:**

#### ***Double Patenting***

Claims 42, 52, 54–60, 62–65, 67–69, 73, 76, and 81 are provisionally rejected under the 15 judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 08/782,481. It is acknowledged that Applicants will file a terminal disclaimer when the claims are otherwise allowable.

Claims 42, 52, 54–60, 62–65, 67–69, 73, 76, and 81 are rejected under the judicially 20 created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 7 of U.S. Patent No. 6,440,419. It is acknowledged that Applicants will file a terminal disclaimer when the claims are otherwise allowable.

Claims 42, 52, 54–60, 62–65, 67–69, 73, 76, and 81 are rejected under the judicially 25 created doctrine of obviousness-type double patenting as being unpatentable over claims 1–11 of U. S. Patent No. 7,022,309. It is acknowledged that Applicants will file a terminal disclaimer when the claims are otherwise allowable.

### **New Formal Matters, Objections, and/or Rejections:**

#### ***Double Patenting***

Claims 42, 52, 54–60, 62–65, 67–69, 73, 76, and 81 are provisionally rejected on the 30 ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–6 of copending Application No. 11/324,947. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because each set of claims is directed to a targeting molecule comprising a J chain. The imaging agent of the copending application's claims overlaps the biological agent of the instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting

5 claims have not in fact been patented.

### ***Claim Objections***

Claims 64 and 65 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or 10 rewrite the claim(s) in independent form.

Linkage via a substrate for an intracellular enzyme or an extracellular enzyme encompasses, for example, glycosidases, phospholipases, esterases, hydrolases, and nucleases. Substrates for such enzymes are not peptide bonds. Hence, the substrate (claims 64 and 65) fails to further limit a peptide bond (claim 42).

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### ***Conclusion***

No claims are allowable.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 9:00 A.M. TO 5:30 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

20 IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL 25 OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING MAY BE OBTAINED 30 FROM THE PATENT APPLICATION INFORMATION RETRIEVAL (PAIR) SYSTEM. STATUS INFORMATION FOR PUBLISHED APPLICATIONS MAY BE OBTAINED FROM EITHER PRIVATE PAIR OR PUBLIC PAIR. STATUS INFORMATION FOR UNPUBLISHED APPLICATIONS IS AVAILABLE THROUGH PRIVATE PAIR ONLY. FOR MORE INFORMATION ABOUT THE PAIR SYSTEM, SEE [HTTP://PAIR-DIRECT.USPTO.GOV](http://PAIR-DIRECT.USPTO.GOV). CONTACT THE ELECTRONIC BUSINESS CENTER (EBC) AT 866-217-9197 (TOLL-FREE) FOR QUESTIONS ON ACCESS TO THE PRIVATE PAIR SYSTEM,

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DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

DSR  
NOVEMBER 26, 2006